



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington DC 20005-3096

COPY MAILED

MAY 24 2004

OFFICE OF PETITIONS

In re Application of
Nozawa et al.
Application No. 10/691,500
Filed: October 24, 2003
Attorney Dck't. No. 61352-050

ON PETITION

This is a decision on the petition filed October 24, 2003, requesting (1) under 37 CFR 1.183 waiver of the provisions of 37 CFR 1.213(a) such that the above-identified application not be published, or, in the alternative, if the aforementioned relief not be granted, that (2) the concurrently filed Request for Non-Publication "be discarded."

The petitions are **dismissed**.

Petitioners assert that two counterpart Japanese applications (Nos. 2001-328807 and 2001-328808, both filed October 21, 2001) have been withdrawn such that they never have been published, and, as such, the "primary basis for allowing an application not to be published [having] been satisfied" petitioners request that the instant application not be published other than by way of issuance as a patent. Petitioners further note that the PCT application of which benefit under 35 U.S.C. § 120 is claimed (No. PCT/JP02/11250 filed October 30, 2002) in this "bypass" application only designated the United States, and as such under PCT Article 64(3) the PCT application will not be published (unless this application is published).

As to waiver under 37 CFR 1.183

37 CFR 1.183, by its terms, cannot be invoked to overcome any requirement of the regulations that is also a requirement of the patent statute. Comparison of 35 U.S.C. § 122 (b)(i) with its promulgating regulation 37 CFR 1.213(a), reveals that both statute and regulation condition pre grant publication in the United States upon the mere **filing** of a counterpart application in a foreign country or under a multilateral international agreement that requires that applications be published at 18 months. That is, pre grant publication is clearly not also conditioned on the ultimate publication—or even the continuing pendency—of the counterpart application in the foreign country or under the multilateral international agreement; only the **filing**. Since the invention filed in the U.S. was the subject of the filed Japanese counterpart applications, then the statutory condition warranting publication of the instant application has been met. It is immaterial that the counterpart Japanese applications were withdrawn or will not now be

published; that they were filed in a country that publishes applications in 18 months is the qualifying and triggering event for publication of the instant application. Accordingly, since petitioner seeks waiver of a condition that is statutory as well as regulatory, the requested waiver simply cannot be granted. The USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute). Here, the USPTO lacks the authority and the discretion to waive the language of 37 CFR 1.213(a) as that language is also statutory. See 35 USC 122(b)(i). Petitioner's comment about the "primary objective" of the non publication provision of the rule, which also appears in the statute, is not persuasive. Whatever may be the Primary objective of Congress when it legislates is immaterial if that objective does not appear in the statute.¹ Since the statute conditions U.S. publication on the mere filing of a counterpart application, the USPTO cannot waive the statutory requirement for publication of this application, notwithstanding the withdrawal and consequent non publication of the counterpart Japanese applications.

As to the requested "discard" of the Non Publication request

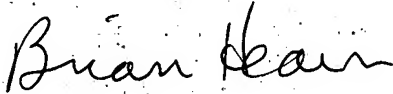
The meaning of petitioner's request is not clear. Petitioner is reminded that a given paper may, under appropriate circumstances, be expunged under 37 CFR 1.59(b), or, say, a non publication request may be "rescinded" if the requirements of the controlling rule are met. See 37 CFR 1.213(b)(1)-(b)(3). Since the request for "discard" is bundled within a paper styled as a petition for the Office of Petitions, this request lacks compliance with 37 CFR 1.4(c). Petitions under 37 CFR 1.59(b) are decided by the Technology Center, and requests for rescission under 37 CFR 1.213(b)(1)-(b)(3) are treated by Pre Grant Publication Division. As such, it would be improper speculation for the Office of Petitions to attempt to divine petitioner's meaning and then itself act on petitioner's request. Petitioner is invited to restate the request in a separate paper dedicated to that purpose and appropriately captioned, and resubmit the amended request to the appropriate part of the USPTO. Chapter 1000 of the MPEP provides

¹ As the Federal Circuit noted when construing § 254 in Southwest Software v. Harlequin, 226 F.3d 852, 56 USPQ2d 1161 (Fed. Cir. 2000):

We begin the process of statutory interpretation with the language of the statute. See Van Wersch v. Department of Health & Human Servs., 179 F.3d 1144, 1148 (Fed. Cir. 1999) (citing VE Holding Corp. v. Johnson Gas Appliance Co., 917 F.2d 1574, 1579, 16 USPQ2d 1614, 1618 (Fed. Cir. 1990)). If the language is clear, the plain meaning is conclusive. See *id.* at 1152 (holding that Congressional intent, as clearly expressed in legislative history, could not "trump the irrefutably plain [statutory] language that emerged when Congress actually took pen to paper").

guidance as to the delegated authority within the USPTO for treating various requests. As a courtesy, a copy of a request for rescission of a prior non publication request is being enclosed with this decision.

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 305-1820.

A handwritten signature in cursive script that reads "Brian Hearn".

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure:

Blank form captioned "Rescission of Previous Non Publication Request"